

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Stanley C. Johnson                      Conf. No.      1478  
Serial No.:                      09/903,795                      Art Unit.:      1745  
Filed:                      July 11, 2001                      Examiner:      Jane J. Rhee  
For:                      WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE  
                                 COVERED WITH PAPER  
Date:                      April 9, 2007

**APPELLANT'S REPLY BRIEF**

Appellant replies to the Examiner's Answer with a date of mailing of January 4, 2006.

Appeal is taken from the Examiner's Office Action mailed May 2, 2005, finally rejecting claims 24-43. This Reply Brief is transmitted in triplicate.

**Argument**

In responding to Appellant's Appeal Brief, the Examiner has set forth two arguments, couched as four, as to why Appellant's invention is obvious. Each of the points raised by the Examiner demonstrates the hindsight nature of the combination, rather than any real motivation to combine. For example, rather than focus on the objective factors of non-obviousness raised by Appellant (commercial success, long-felt need, failure of others, and copying), the Examiner instead refutes a factor that the Appellant did not even raise (unexpected results). Additionally, in making the combination, the Examiner has brought together non-analogous art (panels and trim), each of which serves a different purpose and has different performance requirements, as is established in the failure of motivation.

1. The Examiner has Failed to Set Forth a Valid Motivation to Combine

In responding to Appellant's arguments establishing that the motivation to combine is not present because the Examiner's stated motivation, dimensional stability, runs counter to Appellant's stated purpose to reduce cracking, which is exacerbated by such stability, the Examiner cites *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985), as holding that "another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." See Examiner's Answer, p. 8. However, the Examiner overlooks two factors in citing to this authority. First, *Obiaya* is case involving a claim of unexpected results in a shorter response time. See *Obiaya*, at 60. Appellant has not claimed unexpected results with respect to the present application and, as a result, the case does not stand for a proposition on which Appellant relies. Second, the type of advantage which was found to have flowed naturally in *Obiaya* was speed. Appellant has not claimed an advantage which is based on improving a response time. Because the Examiner's stated motivation would exacerbate the problem Appellant was attempting to solve, the Examiner has not met the burden to establish a *prima facie* case for obviousness, and as a result, the combination fails.

Additionally, rather than focus on whether a motivation to achieve dimensional stability is present, or would even constitute "another advantage which would flow naturally," the Examiner instead takes issue with Appellant's assertion that paper would not be likely to achieve such stability. The issue is not whether paper would in fact increase dimensional stability, but is rather that dimensional stability is not a desirable attribute where the problem being addressed is cracking from too much rigidity, i.e. dimensional stability. As a result, Appellant's motivation is not "another advantage" but rather the opposite of the advantage set forth by the Examiner. The result is that the Examiner's motivation teaches away from Appellant's invention.

## 2. The Examiner Reaches Unsupportable Conclusions

Appellant cannot understand the Examiner's second argument. The Examiner appears to be stating that because Hoffman teaches a resin treatment on the exposed surface of the veneer, it would be obvious to provide Talbot with a resin treatment on the exposed surface of the veneer to obtain a planar smooth surface. Examiner's Answer, page 9. Yet Talbot discloses a veneer wrapping a substrate using a water-base glue system. *See* Talbot, Abstract. There is no suggestion that Talbot lacks a smooth or planar surface for which a resin is required, or that a need for a smooth or planar surface is not supplied by the veneer. As a result, the Examiner's conclusion appears to be unsupported by the citations to the prior art set forth by the Examiner.

## 3. The Examiner's Combination Achieves Less Desirable, Not More Desirable Results

The Examiner continues to argue that Talbot discloses a veneer substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface and that Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets to improve dimensional stability. *See* Examiner's Answer, page 10. With all due respect to the Examiner, the Examiner has not identified, nor do the references explain, how replacing a veneer wrapping with a paper wrapping would improve dimensional stability. Moreover, as previously discussed, even if the Examiner could make such a showing, dimensional stability is not a desirable characteristic for trim product, insofar as too much rigidity results in chipping and cracking of the exposed edge, reducing the durability and aesthetics of the trim. *See* JOHNSON DECLARATION, paragraph 6. Rather than being a combination offering advantages over the references separately, the Examiner's combination would be to replace

the wood veneer wrapping of Talbot with a less desirable (for dimensional stability purposes as the Examiner claims) paper wrapping from Robbins.

#### The Examiner Misconstrues Appellant's Objective Factors

Once again, in stating that Appellant's evidence should establish that the "differences in results are in fact **unexpected** and unobvious and of both statistical and practical significance," the Examiner again is holding Appellant to an objective factor it has not relied on. *See Examiner's Answer*, page 11 [emphasis added]. Appellant has not argued unexpected results, and therefore to assert that Appellant has failed to meet the test for unexpected results is of no moment, and the Examiner's authority is inapposite to the question of obviousness in this matter.

#### **Conclusion**

It is evident that while the Examiner has attempted to set forth four separate grounds on which Appellant's arguments fail, the Examiner in fact raises the same two grounds twice. The first being that the motivation to combine is to achieve dimensional stability, the opposite motivation set forth by Appellant, and the second being that unexpected results, an objective factor Appellant has not asserted, require evidence of a kind not set forth by Appellant. As a result, it is clear that the Examiner, having set forth a hindsight combination, is rigidly clinging to that combination despite that it teaches away from Appellant's invention and despite that Appellant has not relied upon the factor challenged by the Examiner.

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's rejections to all of Appellant's claims.

**Customer No. 20575**

Respectfully submitted,

MARGER JOHNSON & MCCOLLOM, P.C.

A handwritten signature in black ink, reading "Hillary A. Brooks". The signature is written in a cursive style with a horizontal line underneath.

Hillary A. Brooks

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